

REMARKS

Claims 1-20 stand rejected. Claims 3, 5, 8, 11, 13 17-20 have been amended. New claims 21-28 have been added. Claims 1-28 are presently pending. The amended and newly-added claims are supported in the original disclosure. No new matter has been added. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable. Reconsideration of the present application as amended is respectfully requested.

1. Rejection of Claims 3, 5, 8, 11, 12 and 17-20 (35 U.S.C. § 112)

Claims 3, 5, 8, 11, 12 and 17-20 were rejected under 35 U.S.C. § 112, second paragraph, the Examiner alleging they are indefinite. Although Applicant disagrees that any of these claims were indefinite, to streamline prosecution Claims 3, 5, 8, 11, and 17-20 have been amended to remove all “to” expressions. Claims 17-20 have been placed in a more standard “Beareguard” claim form by amending the preamble. No new matter has been added, and no change in claim scope or surrender of claimed subject matter is intended.

Claim 17 was also amended to correct a typographical error. The text has been amended to “a gaming slip”. No change in claim scope or surrender of claimed subject matter is intended.

In view of the foregoing amendments, Applicant submits that Claims 3, 5, 8, 11, 12 and 17-20 are allowable and respectfully requests withdrawal of the rejections under 35 U.S.C. § 112.

2. Rejection of Claims 1, 3-5, 8-10, 13, 16, 17 and 20 (35 U.S.C. § 102(b))

Claims 1, 3-5, 8-10, 13, 16, 17 and 20 were rejected under 35 U.S.C. § 102(b), the Examiner alleging these claims are anticipated by U.S. Patent No. 5,249,801 (Jarvis). Applicant traverses, and respectfully submits that the rejections should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. M.P.E.P. § 2131. Claim 1 recites “a random request region that enables a *plurality* of computer-generated picks to be requested”. Claim 13 recites “generating a *plurality* of picks based on the random request region”. Amended Claim 17 recites “generating a *plurality* of picks based on the random request region”. (Emphasis added.) Applicant respectfully submits that Jarvis fails to teach or suggest each of the limitations of Claims 1, 13 and 17.

Jarvis generally describes a lottery playing card having rows or arrays of numbers. The numbers can be circled by a player to identify a game selection, for example a set of numbers. In the example of the Virginia lottery, a player selects a set of six numbers for each play (col.2, lines 42-45). The player can also automatically select a single random set of numbers without actually having to pick his or her own numbers by filling in box 20. Jarvis’ single random numbers represents a single entry or “quick pick” for the lottery game. Applicant respectfully submits that Examiner may have confused the number of *picks* with how many *numbers* are in a pick. For example, two picks or entries in the Virginia lottery might be:

1-10-13-33-38-40

and

5-11-12-20-25-35

where each of the *two* picks includes *six* numbers from 1 to 44.

The “easy pick” box described by Jarvis allows a player to select a set of *numbers*, but that set forms only one *pick*. Jarvis therefore describes a “binary” easy pick box, where the player can generate zero or one computer-generated pick, and not a *plurality* of picks as recited in Applicant’s claims. The fact that each pick includes more than one number depends on the rules of the particular game being played.

Jarvis failing to anticipate the claimed subject matter, because it does not teach or suggest any approach for making a plurality of computer-generated picks, as recited in Applicant’s claims. Thus, Applicant respectfully submits that Claims 1, 13 and 17 should be allowable over Jarvis.

Claims 3-5, 8-10, 16 and 20 being each dependent on one of Claims 1, 13 and

17, Applicant submits that Claims 3-5, 8-10, 16 and 20 are allowable for at least the same reasons as their respective parent claims.

Moreover, amended Claims 3 and 13, each recite that a pick includes a plurality of randomly selected numbers. Although Jarvis (col.3, lines 8-11) may discuss the selection of a quick pick comprising multiple numbers, it does not teach or suggest a plurality of picks each having a plurality of random numbers.

Regarding Claim 4, the Examiner writes in the Office Action that "Jarvis discloses that a draw request 22 is provided which enables picks to be played for a plurality of drawings". However Claim 4 recites "[a] gaming slip . . . wherein the random request region is part of a game panel, the game panel further including a manual selection region that enables a manual pick to be identified." Applicant sees no relation between the claimed subject matter and the comment and respectfully requests the Examiner to provide further clarification.

Regarding Claim 17, the Examiner indicated a belief that the claim as originally written reads on any computer-readable medium. While Applicant respectfully disagrees, to streamline prosecution, the preamble has been rewritten in a more conventional Beauregard form. All verbs in the infinitive "to" form have been changed to the more conventional gerund "ing" form that is standard in such claims. No new matter has been added, and no change in claim scope or surrender of claimed subject matter is intended or believed to have been made.

For at least the foregoing reasons, Applicant submits that Claims 1, 3-5, 8-10, 13, 16, 17 and 20 are allowable and respectfully request withdrawal of all rejections.

3. Rejection of Claims 2, 6, 7, 11, 12, 14, 15, 18 and 19 (35 U.S.C. § 103(a))

Claims 2, 6, 7, 11, 12, 14, 15, 18 and 19 stand rejected under 35 U.S.C. § 103(a), the Examiner alleging that these claims are unpatentable over Jarvis in view of U.S. Patent No. 5,158,293 (Mullins). Applicant traverses and respectfully submits that the rejections should be withdrawn for at least the following reasons.

First, Claims 2, 6, 7, 14, 15, 18 and 19 each depend on one of Claims 1, 13 and 17. Therefore, these claims should be allowable for at least the reasons given above for

their respective parent claims

Second, the Examiner has failed to provide a proper motivation to combine Jarvis and Mullins. The Examiner's reasoning that the motivation to combine is to allow Jarvis players to participate in different types of games is a hindsight reconstruction that has used the Applicant's claimed invention as a roadmap to pick and choose features from the cited references. To reject, the Examiner must find a suggestion to combine the references that is "clear and particular". *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). Because no proper motivation to combine has been provided, Applicant respectfully submits the obviousness rejection should be withdrawn.

Separately and independently, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2143.03.

Claim 2 recites "a plurality of random request regions, each random request region corresponding to a different type of game". Applicant respectfully submits that the combination of Jarvis and Mullins fails to disclose this limitation of Claim 2.

Mullins generally describes a lottery ticket with two halves, one for an instant lottery, and one for a future draw lottery. The player may use the first half to play a scratch-off type game as soon as he or she buys the ticket, and hold on to the second half to play a future draw lottery. Mullins does not teach or suggest combining two different future draw lotteries and does not provide a plurality of random request regions as recited in Applicant's claim 2. Therefore, Applicant submits that the recited limitation is not in either reference, nor in their combination. Therefore, Claim 2 is not obvious over the proposed combination, and should be allowable.

Claim 11 recites a "Random request region that enables a plurality of computer-generated picks to be requested". Neither Jarvis nor Mullins teach or suggest "a random request region that enables a plurality of computer-generated picks to be requested". Therefore, Applicant submits that Claim 11 is not obvious, and should be

allowable.

Claim 12 depends from Claim 11 and therefore should be allowable for at least the same reasons as claim 11.

Separately and independently, Claims 15 and 19 recite “track[ing] game data for the gaming slip *based on each type of game played on the gaming slip*” (emphasis added). The Applicant respectfully submits the Examiner has not identified this limitation in the cited references. Accordingly the claims should not have been found obvious. To the extent the Examiner is relying on “inherency” to find this limitation in Jarvis, Applicant respectfully traverses. To find an inherent element, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. MPEP 2131.02. That a thing might be present is not sufficient. Applicant respectfully submits that Examiner has not met the strict standard set out for finding inherent elements in the cited references and requests withdrawal of the rejection.

For at least the foregoing reasons, Applicant submits that Claims 2, 6, 7, 11, 12, 14, 15, 18 and 19 are allowable and respectfully request withdrawal of all rejections.

4. New claims

New Claims 21-28 have been added to claim further aspects of Applicant's invention. All new claims are supported throughout the original disclosure, and no new matter has been added.

Amendment A Dated October 26, 2004

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON

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